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66489-082-7

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Karl-Heinz LEHMANN *et al.*

Serial No.: 10/562,939

Filed: December 30, 2005

DENTAL TREATMENT ELEMENT

) PATENT
)
) GROUP: 3732
)
) EXAMINER:
)
) CUSTOMER NO.: 25269
)
) CONFIRMATION NO. 8594

SUBMISSION OF ENGLISH TRANSLATION
OF INTERNATIONAL PRELIMINARY REPORT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 22, 2006

Sir:

The undersigned herewith submits an English translation of the
International Report on Patentability, dated 29 May 2006.

Respectfully submitted,

By:

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PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 20030028PWO	FOR FURTHER ACTION	See item 4 below
International application No. PCT/EP2004/051321	International filing date (<i>day/month/year</i>) 01 July 2004 (01.07.2004)	Priority date (<i>day/month/year</i>) 01 July 2003 (01.07.2003)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant SIRONA DENTAL SYSTEMS GMBH		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).

2. This REPORT consists of a total of 7 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the report |
| <input checked="" type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input checked="" type="checkbox"/> | Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. +41 22 740 14 35	Date of issuance of this report 29 May 2006 (29.05.2006) Authorized officer <div style="text-align: center; font-weight: bold; font-size: 1.2em;">Ellen Moyse</div> Telephone No. +41 22 338 89 75
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PATENT COOPERATION TREATY

Translation

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing
(day/month/year)

Applicant's or agent's file reference 20030028PWO	FOR FURTHER ACTION See paragraph 2 below
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International application No. PCT/EP2004/051321	International filing date (day/month/year) 01.07.2004	Priority date (day/month/year) 01.07.2003
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International Patent Classification (IPC) or both national classification and IPC

Applicant
SIRONA DENTAL SYSTEMS GMBH

1. This opinion contains indications relating to the following items:

<input checked="" type="checkbox"/>	Box No. I	Basis of the opinion
<input checked="" type="checkbox"/>	Box No. II	Priority
<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
<input type="checkbox"/>	Box No. IV	Lack of unity of invention
<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
<input type="checkbox"/>	Box No. VI	Certain documents cited
<input type="checkbox"/>	Box No. VII	Certain defects in the international application
<input checked="" type="checkbox"/>	Box No. VIII	Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/EP	Authorized officer
Facsimile No.	Telephone No.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.
PCT/EP2004/051321

Box No. I Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
☐ This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material
☐ a sequence listing
☐ table(s) related to the sequence listing
 - b. format of material
☐ in written format
☐ in computer readable form
 - c. time of filing/furnishing
☐ contained in the international application as filed.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/051321

Box No. II

Priority

1. ☒ The following document has not yet been furnished:

☒ copy of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(a)).

☐ translation of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date in the claimed priority date.

2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43bis.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.
PCT/EP2004/051321

Box No. V	Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims	4, 5, 10-14	YES
	Claims	1-3, 6-9	NO
Inventive step (IS)	Claims	10, 12	YES
	Claims	1-9, 11, 13, 14	NO
Industrial applicability (IA)	Claims	1-14	YES
	Claims		NO
2. Citations and explanations:			
<p>1. This opinion makes reference to the following document:</p> <p>D1: DE 26 57 675 A (SIEMENS AG) 22 June 1978 (1978-06-22)</p>			
<p>2. INDEPENDENT CLAIM 1</p>			
<p>2.1 Apart from the objection concerning lack of clarity (see Box VIII), the present application does not meet the requirements of PCT Article 33(1), because the subject matter of claim 1 is not novel within the meaning of PCT Article 33(2).</p>			
<p>Document D1 discloses (see page 8, line 31 to page 9, line 4, and figures 1, 3 and 5; the reference signs between parentheses refer to this document):</p>			
<p>Treatment element for receiving dental hand instruments, comprising a base part (26) with connections used to feed the instruments, and further comprising an upper part (1) with an instrument storage place, the upper part being exchangeable, and the <u>treatment element</u> being able to be converted, by exchange of the upper part, from an</p>			

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/051321

Box No. V

Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

appliance of the type with hanging instrument tubes (figure 3) to an appliance in which the instrument tubes are arranged like whips (figure 5).

3. DEPENDENT CLAIMS 2-9

3.1 Claims 2-9 do not contain any features which, in combination with the features of any claim to which they refer, meet the PCT requirements for novelty and inventive step.

3.2 For objections concerning lack of novelty according to PCT Article 33(2), see for example:

- page 9, lines 26-32 and figure 4 for claim 2
- figure 3 for claims 3, 6 and 7
- figure 5 for claims 8 and 9

3.3 Claims 4 and 5 are regarded as simple design possibilities, without being able to justify an inventive step (PCT Article 33(3)).

4. The feature combination contained in dependent claim 10 is not disclosed in the available prior art, nor is it rendered obvious by it. Therefore, claim 10 appears to meet the requirements of PCT Article 33(2) and (3).

5. Claims 11, 13 and 14 are worded so broadly that they cannot be considered inventive (PCT Article 33(3)). A marker that indicates removal is also present when the instrument is not located in its holder or its hollow.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/051321

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

1. The application does not meet the requirements of PCT Article 6, because claim 1 is unclear.

1.1 Claim 1 defines: "...the base part ... by exchange of the upper part ...can be converted ..." (lines 5-6).

However, the description reads: "simple and rapid in situ conversion of the treatment element .. can be changed" (paragraph 12). Therefore, the term "base part" in claim 1 is to be understood as "treatment element".